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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/782,407

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Satoshi Mizutani

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EXAMINER

STEPHENS, JACQUELINE F

ART UNIT

PAPER NUMBER

3761

MAIL DATE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/782,407

**Applicant(s)**

MIZUTANI ET AL.

**Examiner**

Jacqueline F. Stephens

**Art Unit**

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-12 and 14-21 is/are pending in the application.
- 4a) Of the above claim(s) 6-11 and 14-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO-SB06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 12/7/07 have been fully considered, but are not persuasive. Applicant argues Kameo teaches a substantially rectangular cross-section rather than a substantially elliptical cross section. However, the substantially elliptical does not require the cross-section to be entirely elliptical and allows for some variation from an elliptical shape. Additionally, a change in shape is a matter of design choice and within the level of one of ordinary skill in the art. Applicant argues Kameo fails to teach an absorbent article having a first fiber aggregate, a second fiber aggregate, and a third fiber aggregate such that spaces between fibers in the first fiber aggregate and the third fiber aggregate are more flexibly varied than spaces between fibers in the second fiber aggregate. Applicant argues that in contrast, Kameo teaches tightly coupled layers for producing an absorbent article which is prevented from being distorted or twisted while worn and the article is not configured to be flexible. However, the cited section of Kameo (page 2, paragraph 0009 and page 5, paragraph 47, refer to the coupling of the layers not the fibers in the fiber aggregate, and Kameo as stated below teaches a flexible absorbent pad. Applicant further argues Kameo fails to teach the first fiber aggregate and the second fiber aggregate are free of any adhesive agent or pressing applied to any of the first fiber aggregate, the second fiber aggregate, and the third fiber aggregate. However, these limitations are directed to a process of making the article, which is discussed below.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4 Claims 1-4, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kameo et al. EP 0 88 791.

As to claims 1-3, 12, and 13 Kameo teaches a pad capable of being positioned in the interlabial space comprising:

an absorbent body 4 for absorbing liquid, the absorbent body including a fiber aggregate of fiber (paragraph 0026); and a cover body 2,3 for covering the absorbent

body in an enclosing manner (Figure 2); wherein the fibers are oriented randomly (paragraph 0047). The absorbent body flexural rigidity and ratio of flexural rigidities between the longitudinal or lateral direction and the thickness direction of the absorbent body is taught in the structure taught by Kameo. Kameo discloses an absorbent comprising an absorbent member having a specific structure and elastic member having specific physical properties. Kameo teaches the layers of the absorbent component are positioned to prevent distortion (paragraphs 0029 and 0037). Kameo does not specifically teach a substantially elliptical cross-section. However, it would have been an obvious matter of design choice to provide the article of Kameo with an elliptical cross-section shape, since such a modification would have involved a mere change in the shape of the component. A change in shape is generally recognized as being within the level of ordinary skill in the art. *In Re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)

Kameo teaches a first and second fiber aggregate (paragraph 0042). Kameo does not teach a third fiber aggregate. However, Kameo teaches the general condition of multiple fiber aggregates. It is within the level of one of ordinary skill in the art to provide additional fiber aggregates. Kameo fails to teach the first fiber aggregate and the second fiber aggregate are free of any adhesive agent or pressing applied to any of the first fiber aggregate, the second fiber aggregate, and the third fiber aggregate. However, these limitations are directed to a process of making the article. Additionally, the limitations regarding the layering of the fiber aggregates is directed to a process of making the article. "Even though product-by-process claims are limited by and defined

by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

Kameo does not specifically teach providing spaces in the first fiber aggregate and the third fiber aggregate which are more varied than spaces between fibers in the second fiber aggregate. However, Kameo further teaches randomly oriented fibers so that the absorbent is deformable in conformity with the wearer (paragraph 0047). On pages 7-9, the specification sets forth suitable materials making the absorbent article having the claimed characteristics, namely an average fiber length of 10-51mm (page 7, line 12); random fiber orientation (page 9, lines 16-21); and controlling tensile elongation (page 7, lines 6-7). Kameo teaches similar materials for the absorbent (paragraphs 0047-0052). Kameo teaches the absorbent has an elastic member 7 positioned at a vestibular floor side, which due to its thermoplastic composition and elasticity has a higher tensile elongation than the component 6.

Kameo provides an absorbent constructed in a manner and using materials similar to the claimed invention. Thus, Kameo provides an absorbent capable of achieving the claimed test results. When the structure recited in the reference is substantially identical to that of the claims of the instant invention, claimed properties or

functions are presumed to be inherent (MPEP 2112-2112.01). A *prima facie* case of either anticipation or obviousness has been established when the reference discloses all the limitations of a claim except a property or function and the examiner can not determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof as in *In re Fitzgerald*, 619 F.2d 67, 70 205 USPQ 594, 596 (CCPA 1980). In the present case, the reference has met the structural requirements of the claims.

It is the examiner's second position that the claimed test characteristics are obvious in the structure provided by Kameo. Kameo teaches the general conditions of the claims, i.e flexural rigidity, randomly oriented fibers, and an absorbent body formed by layering the fiber aggregate and another fiber aggregate that differ from each other in tensile elongation with the aggregate positioned at the vestibular floor side having a higher tensile elongation. Since, the general conditions of the claims are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. See *In re Aller*, 105 USPQ 233.

The upper and lower sides of the interlabial pad provides the first and second fiber aggregates. Kameo does not provide the claimed vertical height of the first and second fiber aggregate. In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of

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relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

As to claim 4, Kameo teaches layer 7, which is positioned at the vestibular floor is a mix of synthetic fiber (paragraph 0051). The tensile elongation would have been obvious to one of ordinary skill in the art by optimizing the type, fineness, and orientation of the fibers. Moreover, discovering optimum values only involves routine skill in the art, *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of



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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F. Stephens whose telephone number is (571) 272-4937. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jacqueline F Stephens/  
Primary Examiner, Art Unit 3761

March 3, 2008